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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,906	08/22/2003	Robert A. Walker, JR.	50904/RJW/W25	1329
23363	7590	05/13/2005	EXAMINER	
CHRISTIE, PARKER & HALE, LLP			GREENE, JASON M	
PO BOX 7068			ART UNIT	
PASADENA, CA 91109-7068			PAPER NUMBER	
			1724	
DATE MAILED: 05/13/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/646,906

Applicant(s)

WALKER,, ROBERT A.

Examiner

Jason M. Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,2,4,5,7,8 and 10 is/are rejected.
- 7) ☒ Claim(s) 3,6,9,11 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "38" has been used to designate both band and the inner perimeter of the cover in Fig. 6. It appears as though reference character "38" designating the inner perimeter of the cover should be changed to reference character "30". See page 8, lines 2-4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claims***

2. Claim 4 recites the limitation " means for releasably connecting the cover sidewall to the engine filter" in lines 7-8. However, the recitation of "an engine filter"

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follows the recitation of the connecting means. The Examiner suggests Applicants rewrite the claim such that the recitation of the connection means appears after the recitation of the engine filter to clarify antecedent basis. The Examiner notes that the "engine filter" recited in line 8 has been interpreted as being the engine filter recited in line 9.

3. With regard to claim 11, the phrase "a slot is formed in the lower end of the enclosure" in lines 2-3 has been interpreted to mean that the enclosure is oriented such that it has a lower end having a slot formed therein. If this interpretation is correct, the Examiner suggests Applicants rewrite the phrase "the lower end" in line 3 as "a lower end" to clarify antecedent basis.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 4, 5, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Gilliam et al.

With regard to claims 1 and 2, Gilliam et al. discloses a protective cover (5) for an engine filter (1,11) comprising a cover upper portion and at least one side wall connected to the cover upper portion, wherein the cover upper portion and the at least one cover sidewall form an enclosure, such that an inner perimeter of the enclosure has a size and a shape corresponding to a size and a shape of an outer perimeter (the outer perimeter of filter element 11) of the engine filter, and means for releasably connecting the cover sidewall to the engine filter, wherein the means for releasably connecting comprises a clamp (band 12) that is disposed around an outside surface of the at least one cover sidewall in Figs. 1-6 and col. 2, line 51 to col. 3, line 23.

With regard to claims 4 and 5, Gilliam et al. discloses an assembly comprising a protective cover (5) comprising a cover upper portion and at least one cover sidewall attached to the cover upper portion, wherein the cover upper portion and the at least one cover sidewall form an enclosure, an engine filter (1,11) having an outer perimeter, wherein an inner perimeter of the enclosure has a size and a shape similar to a size and a shape of the outer perimeter of the engine filter, and means for releasably connecting the cover sidewall to the engine filter, wherein the means for releasably connecting comprises a clamp (band 12) that is disposed around an outside surface of the at least one cover sidewall in Figs. 1-6 and col. 2, line 51 to col. 3, line 23.

With regard to claim 7, Gilliam et al. discloses a protective assembly for filters for internal combustion engines comprising a domed enclosure (5) of a first predetermined

height and width, an engine filter (1,11) of a second predetermined height and width adapted to be secured to an internal combustion engine for receipt of fluids to be filtered from the engine, and an adjustable (between the open and closed positions) clamp (band 12) mounted on the enclosure for securing and releasing the enclosure from the filter, wherein the first height and weight of the enclosure is selected to receive and enclose the filter of the second height and width in a vibration resistant condition (due to gasket 8) in Figs. 1-6 and col. 2, line 51 to col. 4, line 8.

With regard to claim 8, Gilliam et al. discloses the clamp being a band (12) having a tightening mechanism (toggle lever 15) extending around the exterior of the enclosure in Figs. 1-8 and col. 3, lines 9-36.

6. Claims 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Lowther et al.

Lowther et al. discloses a protective assembly for filters for internal combustion engines comprising a domed enclosure (8) of a first predetermined height and width, an engine filter (7,12) of a second predetermined height and width adapted to be secured to an internal combustion engine for receipt of fluids to be filtered from the engine, and an adjustable clamp (band 14) mounted on the enclosure for securing and releasing the enclosure from the filter, wherein the first height and weight of the enclosure is selected to receive and enclose the filter of the second height and width in a vibration resistant condition, wherein the clamp is a band (14) having a tightening mechanism (rod 17 and

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nut 18) extending around the exterior of the enclosure in Figs. 1-6 and page 1, col. 2, line 40 to page 2, col. 1, line 40.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hebert in view of Roll.

With regard to claim 1, Hebert discloses a protective cover (6) for an engine filter (4) comprising a cover bottom portion and at least one side wall connected to the cover bottom portion, wherein the cover bottom portion and the at least one cover sidewall form an enclosure, such that an inner perimeter of the enclosure has a size and a shape corresponding to a size and a shape of an outer perimeter of the engine filter (4), and means (magnetized adapter sleeve 90) for releasably connecting the cover sidewall to the engine filter in Figs. 1-3 and col. 3, line 26 to col. 4, line 64.

Hebert does not disclose the protective cover having an upper portion connected to the sidewall.

Roll teaches orienting engine filters such that the fluid to be filtered enters from a bottom portion of the filter in Figs. 1 and 2.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the orientation of Roll into the protective cover of Hebert to allow the protective cover to be utilized with engine filters that are installed such that the fluid to be filtered enters the lower end of the filter.

With regard to claim 4, discloses an assembly comprising a protective cover (6) comprising a cover bottom portion and at least one cover sidewall attached to the cover bottom portion, wherein the cover bottom portion and the at least one cover sidewall form an enclosure, an engine filter (4) having an outer perimeter (8), wherein an inner perimeter of the enclosure has a size and a shape similar to a size and a shape of the outer perimeter of the engine filter, and means (magnetized adapter sleeve 90) for releasably connecting the cover sidewall to the engine filter in Figs. 1-3 and col. 3, line 26 to col. 4, line 64.

Hebert does not disclose the protective cover having an upper portion connected to the sidewall.

Roll teaches orienting engine filters such that the fluid to be filtered enters from a bottom portion of the filter in Figs. 1 and 2.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the orientation of Roll into the protective cover of



Hebert to allow the protective cover to be utilized with engine filters that are installed such that the fluid to be filtered enters the lower end of the filter.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lowther et al.

Lowther et al. discloses the clamp having two end tabs (15,16) joined by a bolt and screw combination (17,18) for securing the clamp to the filter in Fig. 1 and pag2 2, col. 2, lines 22-40

Lowther et al. does not disclose the clamp being integrally formed in the enclosure.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate the clamp into the enclosure in that making parts integral is merely a choice of design. See *In re Larson*, 144 USPQ 347 and *In re Lockhart*, 90 USPQ 214. Additionally, one of ordinary skill in the art would have also recognized that the clamp could be integrally formed with the enclosure to facilitate maintenance procedures by reducing the number of separate parts that the maintenance technician has to keep track of. The Examiner notes that the phrase "the clamp is integrally formed in the enclosure" has been interpreted to mean that the clamp is formed as an integral part of the enclosure. The phrase has not been interpreted as requiring the clamp to be in an interior portion of the enclosure.

10. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gilliam et al. in view of Lowther et al.

Gilliam et al. discloses the clamp (band 12) having two end tabs (21,21) for securing the clamp to the filter in Figs. 7 and 8 and col. 3, lines 24-36.

Gilliam et al. does not disclose the clamp being integrally formed in the enclosure and having two end tabs joined by a bolt and screw combination.

Lowther et al. discloses a similar protective assembly comprising a clamp having two end tabs (15,16) joined by a bolt and screw combination (17,18) for securing the clamp to the filter in Fig. 1 and pag2 2, col. 2, lines 22-40.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the bolt and screw combination of Lowther et al. into the protective assembly of Gilliam et al. to allow the pressure exerted by the clamp to be adjusted, as suggested by Lowther et al. in page 2, col. 1, line 23 to page 2, col. 2, line 24.

#### ***Allowable Subject Matter***

11. Claims 3, 6, 9, 11 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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12. The following is a statement of reasons for the indication of allowable subject matter:

With regard to claims 3 and 6, Gilliam et al. and Lowther et al disclose the clamp being disposed concentrically on an outside surface of the at least one cover sidewall.

The prior art made of record does not teach or fairly suggest the protective cover of claim 1 or the assembly of claim 4 wherein the means for releasably connecting comprises a clamp that is disposed concentrically within an inside surface of the at least one cover sidewall, and that is connected to the at least one cover sidewall.

With regard to claim 9, Gilliam et al. and Lowther et al. disclose the clamp being a band having a tightening mechanism extending around the exterior of the enclosure.

The prior art made of record does not teach or fairly suggest the protective assembly of claim 7 wherein the clamp is a band having a tightening mechanism extending around and secured to the interior of the enclosure.

With regard to claims 11 and 12, Gilliam et al. and Lowther et al. disclose the clamp being mounted exteriorly of the enclosure, wherein the ends of the clamp are connected together with an adjustable linkage.

The prior art made of record does not teach or fairly suggest the protective assembly of claim 7 wherein the clamp is mounted interiorly of the enclosure and

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wherein a slot is formed in the lower end of the enclosure, the ends of the clamp extending out of the slot and being connected together with an adjustable linkage.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Cox, Watson, Claar, Tanabe et al., Vandenberghe et al., Harvey and Baert et al. references disclose similar assemblies.

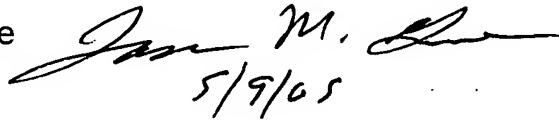
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Greene whose telephone number is (571) 272-1157. The examiner can normally be reached on Monday - Friday (9:00 AM to 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason M. Greene  
Examiner  
Art Unit 1724



5/9/05

jmg  
May 9, 2005